

**REMARKS**

Applicant concurrently files herewith a Petition for Extension of Time, and corresponding extension of time fee, for a three-month extension of time.

Claims 1-12 are all the claims presently pending in the application. Applicant has amended claims 1-7 to define the claimed invention more particularly. Applicant has added new claims 11 and 12 to claim additional features of the invention and to provide varied protection for the claimed invention.

It is noted that the claims amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims, or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claim 7 stands rejected under 35 U.S.C. § 101, as being directed to non-statutory subject matter. Claims 1, 2, 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamaguchi, et al. (U.S. Patent No. 6,824,463; hereinafter “Yamaguchi”). Claims 3 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamaguchi in view of Morsch (U.S. Patent No. 2,668,716). Claims 4-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamaguchi in view of Sher (U.S. Patent No. 5,775,440).

These rejections are respectfully traversed in the following discussion.

**I. THE CLAIMED INVENTION**

The claimed invention (e.g., as defined by exemplary claim 1) is directed to gaming machine.

The gaming machines includes a plurality of lottery boards, each of which is provided with a plurality of lottery holes and a face portion on which a lottery ball can roll, a game result determination device for determining a game result on a basis of identification information associated with any one of the plurality of lottery holes receiving the lottery ball under a condition that the lottery ball enters any one of the plurality of lottery holes, each of the plurality of lottery holes of the lottery boards being associated with identification information for determining a lottery result (e.g., see Application at page 23, line 3 through page 24, line 5).

The claimed invention, as defined above, provides a gaming machine in which the results of the gaming machine are not predictable or regular to the game player (e.g., see Application at page 23, lines 16-22).

## **II. THE §101 REJECTION**

The Examiner alleges that the claimed invention of claim 7 is not directed to statutory subject matter.

While Applicant disagrees with the Examiner's allegation that the program recited in claim 7 is per-se non-statutory, merely in an effort to speed prosecution, Applicant has amended claim 7 to recite a "*computer implemented readable medium encoded with a computer program*", as provided in the above listing of claims.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection.

## **III. CLAIM REJECTIONS BASED ON PRIOR ART GROUNDS**

### **A. The Yamaguchi Reference**

The Examiner alleges that the claimed invention of claims 1, 2, 8 and 9 would have

been obvious in view of Yamaguchi. Applicant submits, however, that there are features of the claimed invention that are neither taught nor suggested (nor made obvious) by Yamaguchi.

That is, Yamaguchi does not teach or suggest (nor make obvious) a gaming machine including “*a plurality of lottery boards, each of which is provided with a plurality of lottery holes and a face portion on which a lottery ball can roll*”, as recited in exemplary claim 1, and somewhat similarly recited in claims 4, 5, 7 and 8.

The Examiner concedes that Yamaguchi does not teach or suggest this feature of the claimed invention (e.g., see Office Action dated May 3, 2007 at page 3). The Examiner, however, alleges, “*the addition of another lottery board is mere duplication of parts, as it does produce (sic) a new and unexpected result in the game, and thus would have been obvious to one of ordinary skill in the art at the time of the invention.*”

Applicant submits, however, in the case of a game machine with only one lottery board, as disclosed in Yamaguchi, lottery holes are merely provided around the circumference of the lottery board, and thus the size of the lottery board must increase in order to increase the number of lottery holes to provide enjoyment to a user playing the game.

In stark contrast, each of the lottery boards of the claimed invention has lottery holes provided over the entire lottery board, and thus a greater number of lottery holes can be provided, compared to the game machine according to Yamaguchi.

Furthermore, substantially the same number of lottery holes can be provided on a plurality of lottery boards when the total circumferential length is substantially the same (e.g., as defined in dependent claims 11 and 12) as that of a single lottery board, as can be seen by comparing the invention of Yamaguchi, which uses one circular lottery board, to the claimed invention, which employs a plurality of lottery boards. When a plurality of lottery boards are used, the radius of each lottery board can be reduced to half of that of a single circular lottery

board.

Accordingly, when a plurality of lottery boards is used, as in the claimed invention, the total area of the lottery boards can be reduced. By using a plurality of lottery boards as described above, the enjoyment a user experiences while playing the game can be maintained while minimizing the physical footprint that the game occupies. Furthermore, by providing a plurality of lottery holes along a plurality of circumferences, the enjoyment a user experiences while playing the game can be maintained while minimizing the physical footprint that the game occupies.

Thus, Applicant submits that the problem solved by the claimed invention would not have been recognized by one of ordinary skill in the art.

Therefore, Applicant submits that there are features of the claimed invention that are not taught or suggested (nor made obvious) by Yamaguchi. Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection.

#### **B. The Morsch Reference**

The Examiner alleges that Morsch would have been combined with Yamaguchi to teach the claimed invention of claims 3 and 10. Applicant submits, however, that, even if combined, the alleged combination of references does not teach or suggest each and every feature of the claimed invention.

Applicant submits that claims 3 and 10 are allowable based on similar arguments to those set forth above in section A, with respect to claims 1, 2, 8 and 9. For brevity, Applicant has not repeated the above arguments herein.

Furthermore, Applicant submits that Morsch fails to make up the deficiencies of Yamaguchi.

Indeed, the Examiner merely attempts to rely on Morsch as teaching a cabinet and a

tilting control ~~means~~ device.

Thus, Morsch fails to make up the deficiencies of Yamaguchi.

Therefore, Applicant submits that there are features of the claimed invention that are not taught or suggested (nor made obvious) by the alleged combination of Yamaguchi and Morsch. Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection.

### **C. The Sher Reference**

The Examiner alleges that Sher would have been combined with Yamaguchi to teach the claimed invention of claims 4-7. Applicant submits, however, that, even if combined, the alleged combination of references does not teach or suggest each and every feature of the claimed invention.

Applicant submits that claims 4-7 are allowable based on similar arguments to those set forth above in section A, with respect to claims 1, 2, 8 and 9. For brevity, Applicant has not repeated the above arguments herein.

Furthermore, Applicant submits that Sher fails to make up the deficiencies of Yamaguchi.

That is, the Examiner alleges that Yamaguchi discloses a rotation control mechanism that “dynamically changes...the rotational direction” of the rotating unit, as well as a supply-mechanism control unit for controlling the release of the balls, and that Sher discloses first and second ball throwing means for launching two balls onto the lottery board, and being capable of launching the balls in any direction.

The game machine described in Sher, however, merely includes two parts for throwing lottery balls, but cannot throw lottery balls in any specific direction.

In stark contrast, however, in the game machine of the claimed invention, the

throwing direction of the lottery ball and the rotational direction of the lottery board are substantially coincident with each other.

Accordingly, in the game machine of the claimed invention, the speed of the lottery ball is prevented from rapidly being reduced when coming into contact with the lottery board, and, thus, the lottery ball does not as readily enter a lottery hole. Therefore, the claimed invention provides a game where it is difficult to predict which lottery hole a lottery ball will enter and, thus, a user will be more impatient and experience a heightened degree of anticipation. In addition, by rotating the lottery board clockwise and counterclockwise, multiple variations of the game are possible, which further increases the entertainment capability of the game and reduces the likelihood of the user becoming bored while playing the game.

Thus, Sher fails to make up the deficiencies of Yamaguchi.

Therefore, Applicant submits that there are features of the claimed invention that are not taught or suggested (nor made obvious) by the alleged combination of Yamaguchi and Sher. Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection.

#### **IV. NEW CLAIMS**

Applicant has added new claims 11 and 12 to provide varied protection for the claimed invention and to claim additional features of the invention. These claims are independently patentable because of the novel features recited therein.

Applicant respectfully submits that new claims 11 and 12 are patentable over any combination of the applied references at least for analogous reasons to those set forth above with respect to claims 1-10.

**V. FORMAL MATTERS AND CONCLUSION**

In view of the foregoing, Applicant submits that claims 1-12, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

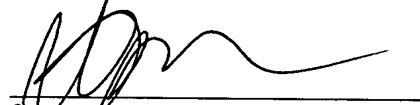
Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Date:

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Respectfully Submitted,



Scott M. Tulino, Esq.  
Registration No. 48,317

Sean M. McGinn  
Registration No. 34,386

**McGinn Intellectual Property Law Group, PLLC**  
8321 Old Courthouse Road, Suite 200  
Vienna, VA 22182-3817  
(703) 761-4100  
Customer No. 21254